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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/755,031 | 01/08/2001 | William Chadwick | INF 2005 | 3569 |

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EXAMINER

WALLS, DIONNE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1731

5

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,031

Applicant(s)

CHADWICK, WILLIAM

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's telephonic election of Group I, claims 1-10, was acknowledged by the Examiner in the previous Office Action, which included a Restriction Requirement. Because Applicant, in the Amendment filed on 8-9-02, did not distinctly and specifically point out any errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3140831 in view of Whitson-Fischman (US. Pat. No. 5,162,037).

DE 3140831 discloses all that is recited in the claims (Note: "sugar/powder" corresponds to the claimed "base ingredient"; "peppermint/mint/cloves" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/"masking agent"; "menthol" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/"antiseptic agent"; "powder" corresponds to the claimed "base ingredient....solid form"; see attached English abstract) except it may not explicitly state that the Plantago major component is in the form of a homeopathic preparation. However, Whitson-Fischman discloses that it is known to use homeopathic

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(i.e. extremely diluted) preparations of herbs, designed to be orally administered, for the treatment of addictive chemical dependencies (see col. 1, lines 15-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize a homeopathic preparation of *Plantago major* in the composition of DE 3140831 in order to receive the added benefits of a mixture prepared based on the art of homeopathy, disclosed in Whitson-Fischman, which focuses on the healing of persons with addictive dependencies. Also, while there may be no explicit articulation of whether the “menthol” (corresponding to the claimed “additive for diminishing the odor characteristic of tobacco”) is provided in an “effective amount”, the Examiner believes that the DE 3140831 reference satisfies this limitation. The phrase “effective amount” can mean different things to different observers, and without further-clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the DE 3140831 reference, since menthol has been added in the amount of .21 weight%. Also, it follows that this claim limitation has been met since any addition of the menthol substance would also obviously be effective to diminish the odor characteristic, at least to some extent, even if it is negligible based on Applicant’s standards.

3. Claims 1-2 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cody (US. Pat. No. 6,063,401) in view of Whitson-Fischman (US. Pat. No. 5,162,037).

Cody discloses all that is recited in the claims (Note: “liquid carriers/liquid core solvents” correspond to the claimed “base ingredient/liquid form”; “pill” corresponds to

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the claimed "solid form"; "citric acid" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/ "neutralizing agent"; col. 2, lines 38-40; cols. 5 and 6) except it may not explicitly state that the *Plantago* major component is in the form of a homeopathic preparation. However, Whitson-Fischman discloses that it is known to use homeopathic (i.e. extremely diluted) preparations of herbs, designed to be orally administered, for the treatment of addictive chemical dependencies (see col. 1, lines 15-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize a homeopathic preparation of *Plantago* major in the composition of Cody in order to receive the added benefits that the art of homeopathy, as disclosed in Whitson-Fischman, has in the healing of persons with addictive dependencies. Also, while there may be no explicit articulation of whether the "citric acid" (corresponding to the claimed "additive for diminishing the odor characteristic of tobacco") is provided in an "effective amount", the Examiner believes that the Cody reference satisfies this limitation. The phrase "effective amount" can mean different things to different observers, and without further clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the Cody reference, since the citric acid has to be added to the composition of Cody in an amount effective to serve its purpose. Also, it follows that this claim limitation has been met since any addition of citric acid would also obviously be effective to diminish the odor characteristic at least to some extent, even if it is negligible based on Applicant's standards.

4. Claims 1-2, 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitson-Fischman (US. Pat. No. 5,162,037) in view of Cody (US. Pat. No. 5,716,635).

Whitman-Fischman discloses a composition for the treatment of chemical dependencies in the form of a lollipop (corresponding to the claimed “base ingredient”/ “solid form”), upon which a homeopathic mixture of an herb and extract of citrus seed (corresponding to the claimed “additive for diminishing the odor characteristics of tobacco” / “neutralizing agent” / “citrus extract”) is applied (col. 1, lines 15-21 and 47-49; col. 2, lines 33-34; col. 7, lines 33-44; col. 8, lines 52-54; see examples 1 and 24; see fig. 1). While Whitman-Fischman may not disclose that the homeopathic herbal mixture comprises *Plantago major* as its herb, Cody discloses in its “Background of the Invention” section that the herb *Plantago major* has been known as a tobacco deterrent for many years (col. 2, lines 63-65), and that the oral administration of *Plantago major* caused an aversion to tobacco in humans. Also, it is stated that various dilutions in ethanol and water of the herb has also been used orally (col. 3, lines 1-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include *Plantago major* as an herb in the homeopathic mixture of Whitman-Fischman because, as taught in Cody, such herb, in dilute forms, is known for its benefits in encouraging a smoker’s withdrawal from nicotine which is consistent with the goal of the composition in Whitson-Fischman – treating addictive dependencies using herbal mixtures. Also, while there may be no explicit articulation of whether the “extract of citrus seed” (corresponding to the claimed “additive for diminishing the odor

characteristic of tobacco”) is provided in an “effective amount”, the Examiner believes that the Whitson-Fischman reference satisfies this limitation. The phrase “effective amount” can mean different things to different observers, and without further clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the Whitson-Fischman reference, since the extract of citrus seed has to be added to the composition of Whitson-Fischman in an amount effective to serve its purpose. Also, it follows that this claim limitation has been met since any addition of extract of citrus seed would also obviously be effective to diminish the odor characteristic at least to some extent, even if it is negligible based on Applicant’s standards.

Response to Arguments

5. Applicant’s arguments with respect to the claims have been considered but because of amendments made to the claims, new grounds of rejection have been made. Any arguments not rendered moot by the new grounds have been adequately addressed in the above rejection.

Conclusion

6. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

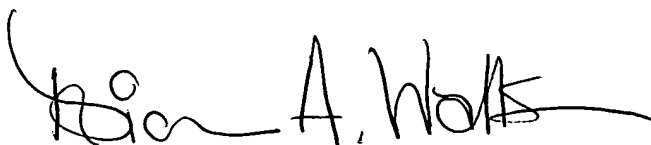
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Dionne A. Walls
October 8, 2002



STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
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